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Paper No. 27

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APR 03 2009

OFFICE OF PETITIONS

In re Application of :
Engelhardt et al. :
Application No. 08/182,621 : ON PETITION
Filed: January 13, 1994 :
Attorney Docket No. ENZ52 : .

This is in response to the papers filed November 11, 2008, in the above-identified application, namely, 1) the PETITION UNDER 37 C.F.R. 1.182 FOR EXPEDITED CONSIDERATION OF REQUESTS TO VACATE ORDER TO SHOW CAUSE AND TO EXPUNGE CONFIDENTIAL INFORMATION FROM PUBLIC RECORDS, 2) the REQUEST TO EXPUNGE CONFIDENTIAL APPLICATIONS FROM ORDERS TO SHOW CAUSE UNDER 37 CFR 1.181, and 3) the REQUEST TO VACATE ORDER TO SHOW CAUSE WHY DECISION REVIVING THIS APPLICATION SHOULD NOT BE VACATED.

The Petition Under 37 CFR 1.182 for Expedited Consideration of Petition to Expunge Confidential Information concerning this Application from Public Records is GRANTED.

The Petition Under 37 CFR 1.182 for Expedited Consideration of Request to Vacate Order to Show Cause is DENIED.

The Request to Expunge Confidential Information is GRANTED to the extent indicated herein.

The Request to Vacate Order to Show Cause is DISMISSED.

Applicants are given **TWO MONTHS** from the mail date of this decision to provide the information requested in response, or otherwise respond, to the Order to Show Cause. This period is extendable under 37 CFR 1.136(a).

BACKGROUND

On July 2, 2008, the Office issued an Order to Show Cause why the decisions mailed March 6, 1995, November 26, 1996 and April 15, 1998 reviving this application should not be vacated.

Considering a pattern of abandonment and revival in multiple applications, the Order required *inter alia* further information as to i) the cause of any delay between the date the application became abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, ii) the cause of any delay between the date the applicant was first notified that the application was abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, and iii) how these delays were "unintentional." The Order specifically required explanation of the docketing system used for recording due dates for response to an Office communication and how it operated, and copies of relevant docket entries. The Order set a two-month period for response with extensions of time obtainable under 37 CFR 1.136(a).

In response, applicants filed the above-described papers. Pursuant to applicants' authorization, the extension of time fee¹ necessary to consider applicants' responses timely filed is being charged to Deposit Account No. 50-2929. It is noted that the papers filed in response did not include an explanation of the docketing system or copies of docketing records. This decision considers each of the papers, in turn, as follows: First, consideration will turn to applicants' Petition for Expedited Consideration. Then, the decision will respond to applicants' Request to Expunge Confidential Applications from the Order. Finally, the decision will address applicants' Request to Vacate the Order to Show Cause.

**ON PETITION UNDER 37 C.F.R. 1.182
FOR EXPEDITED CONSIDERATION OF
REQUESTS TO VACATE ORDER TO SHOW CAUSE
AND TO EXPUNGE CONFIDENTIAL INFORMATION FROM PUBLIC RECORDS**

On November 11, 2008, applicants filed the petition under 37 CFR 1.182 for expedited consideration of their REQUESTS TO VACATE

¹ The two-month period for response to the Order mailed July 2, 2008 ended on September 2, 2008. To make the responses filed November 11, 2008 timely, an extension of time for response within the third month (\$1050) to extend the period to December 2, 2008 has been charged.

ORDER TO SHOW CAUSE and TO EXPUNGE CONFIDENTIAL INFORMATION FROM PUBLIC RECORDS, also filed November 11, 2008.

The Petition to Expedite consideration of Petition to Expunge Confidential Information concerning this Application from Public Records is GRANTED.

The Petition to Expedite consideration of Request to Vacate Order to Show Cause is DENIED.

Applicants request expedited consideration of their Request to Expunge in order to restore confidentiality and to maintain in confidence all information concerning the above-referenced application. Applicants allege that the Office's inclusion of confidential information concerning this application in the Order to Show Cause by placement of the Order in at least one patented file is a direct violation of the statute, 35 U.S.C. 122(a), and the regulation, 37 C.F.R. § 1.14(a). Applicants request that the Office expedite consideration of their Request to Vacate the Order to Show Cause on the basis that if it is ultimately granted such a decision would alleviate any further expenditure of applicants' time and resources in preparing responses to any vacated Orders to Show Cause. Furthermore, while acknowledging that the Petitions to Expedite are properly considered pursuant to 37 CFR 1.182, applicants maintains that the required fee for such consideration should not be required as the inclusion in the Order to Show Cause of confidential information concerning this application was a mistake on the part of the Office, as was the entire act of issuing the Order to Show Cause.

Preliminarily, the issue of payment of the required petition fee must be addressed. Payment of a fee of \$400 is required for consideration on the merits of a petition pursuant to 37 CFR 1.182. As acknowledged by applicants, a Petition to Expedite is a petition pursuant to 37 CFR 1.182. Nonetheless, there is merit to an argument that no fee should be required to expedite consideration of a petition requiring, if granted, prompt removal of confidential information issued in error by the Office. By rule, the Office does not require payment of a fee to advance consideration of the examination of applications where the Office has determined that such expedited consideration is warranted. See 37 CFR 1.102(c). In addition, the Office by practice does not require a fee for immediate action on a petition to withdraw an application from issuance

given that a delay in acting on such a petition would render the relief meaningless (e.g. the application would have issued as a patent before the petition to withdraw from issue could be granted). The justifications for not paying a fee for expedited consideration of a petition to expunge confidential information based upon an action of the USPTO are equally persuasive.

First, there is a compelling public interest in the Patent and Trademark Office keeping in confidence confidential application information and thus, in addressing any allegation that they have not. Second, it is warranted that an applicant file a petition to expedite with respect to alleged disclosure of confidential information to draw attention to a petition alleging such violation and to effectuate any remedial action. Absent the filing of such a petition, the Office may not become aware of the issue presented until the petition on the merits is considered in turn and the confidential information has been open to the public. On its face, the Petition to Expedite consideration of the Petition to Expunge Confidential Information warrants consideration without a fee.

However, applicants also request expedited consideration of the Request to Vacate the Order to Show Cause. The Office is not of the opinion that the Orders to Show Cause were issued by mistake. Applicants submits no persuasive argument, nor does the Office find any compelling reason, to waive the fee required for consideration of the petition to expedite consideration of the Request to Vacate the Order to Show Cause. Accordingly, the \$400 fee is required and will not be waived. The petition fee has been charged to the Deposit Account, as authorized.

Consideration now turns to the merits of the petitions to expedite. A petition to expedite a decision on a petition is treated as a request that upon making a showing justifying such action the Office take up for consideration a petition out of turn.

Applicants' basis for requesting expedited consideration of the Request to Expunge Confidential Information is to ensure fulfillment of the statutory requirement that the Office preserve in confidence patent applications. Failure to act on such a Request leaves a question as to whether confidential information has been made available to the public. Such justifications warrant that the Office consider the Request to Expunge Confidential Information out of turn.

However, the mere fact that applicants have to expend resources to respond to the Orders to Show Cause does not justify considering the Request to Vacate out of turn. The argument that the Order was issued in error is an argument on the merits of the Order to Show Cause, and is properly presented in a response on the merits to the Order. Even if a decision on the Order to Show Cause were ultimately issued in favor of applicants, this does not warrant consideration of their Request out of turn. Their articulated interest in alleviating expenditure of time and resources in preparing a response is no more compelling than the interest of any other applicant awaiting action by the Office.

In view thereof, this decision also addresses the Petition to Expunge Confidential Information.

Nonetheless, as the application is before the reviewing attorney for consideration of the Petition to Expunge, the Request to Vacate the Order to Show Cause will also be addressed.

**ON REQUEST TO EXPUNGE CONFIDENTIAL APPLICATIONS
FROM ORDERS TO SHOW CAUSE UNDER 37 CFR 1.181**

On November 11, 2008, applicants filed a REQUEST TO EXPUNGE CONFIDENTIAL APPLICATIONS FROM ORDERS TO SHOW CAUSE UNDER 37 CFR 1.181.

The Request is GRANTED to the extent indicated herein. The Order will not be rescinded; however, a substitute redacted Order will be issued.

Applicants maintain that under 37 C.F.R. § 1.14, an unpublished application, as here, whether pending or abandoned, is maintained confidential unless it is relied upon for priority purposes by a published application or patent, a circumstance not present here. Applicants assert that information concerning this non-published and non-patented application has improperly been included in the publicly available Orders to Show Cause, contrary to 37 C.F.R. § 1.14(a). Specifically, applicants allege that the Office's inclusion of confidential information concerning this application in the Order to Show Cause by placement of the Order in at least one patented file is a direct violation of the statute, 35 U.S.C. 122(a), and the regulation, 37 C.F.R. § 1.14(a). Applicants request that all currently

issued Orders to Show Cause be expunged from the public eye. Applicants further ask that the Order be reissued to remove from (1) the caption, (2) both tables, and (3) the body of the Order reference to this confidential application. Applicants further request that any discussion of the confidential application be removed from the reissued Orders.

Applicants' arguments have been considered, but not found wholly persuasive. The Order to Show Cause mailed July 2, 2008, identified this application and discussed its prior abandoned status, and identified published and non-published patent applications and patents in the header/caption, in a table and in the text of the body of the Order and discussed their prior abandoned status. However, the identification and discussion of these other applications did not abridge the confidentiality of this unpublished application in violation of the statute. The contents of this application were kept in confidence, while as allowed by the statute information regarding the previous abandoned status was given under such special circumstances as determined by the Director. The statute, 35 U.S.C. 122, states that:

Except as provided in subsection (b)², applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

With respect to such unpublished applications, the implementing regulation, 37 CFR 1.14, provides:

Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

All papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the

² It is noted that subsection (b) provides for the publication of applications. As noted by applicants, the instant application is not published.

payment of the fee set forth in § 1.19(b)(2). However, the public may not have access to an unpublished pending application, unless the application is otherwise identified in a patented or published application³.

Thus, applicants are correct that the public may have access to the files of any published or patented applications that contain the Order to Show Cause. However, the fact that the Order identifies this application does not give the public the access suggested by applicants. The application contents remain preserved in confidence. With respect to public access, applicants do not acknowledge a significant distinction in the access to an unpublished pending application identified in the file contents of another application but not in the published patent application or the patent itself. Pursuant to 37 CFR 1.14(a), (vi), where an unpublished pending application is otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2), a copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)). However, if an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (h)) or a power to inspect (see paragraph (c)) is necessary to obtain the application, or a copy of the application. (It is noted that an application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent). Furthermore, a power to inspect is only granted by delegation from a party with access and a petition for access is only granted upon a showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant applicants being granted access to all or part of the application. Thus, the mere reference to this pending unpublished application does not

³ or subject of a benefit claim or the application is incorporated by reference.

give the public such access to the contents of this application to consider its confidentiality breached.

Finally, the statute is not absolute. The statute allows for information concerning a confidential application to be given in such special circumstances as may be determined by the Director. In this instance, special circumstances existed that required some reference to the previously abandoned status (and subsequent revival) of specifically identified applications, including this unpublished pending application. Specifically, the basis for the Order to Show Cause and the information requested in the Order related to the exact dates and periods of abandonment of this application in conjunction with the exact dates and periods of abandonment of several other applications. Accordingly, this limited information had to be stated in order to effectuate the Order and to identify for Enzo the exact questions raised by the Order.

This purpose having been served, the Order will not be rescinded; however, the Order will be expunged to the degree permitted by the image file wrapper system. As such, the document will remain closed⁴ in the image file wrapper and thus, will not be available to the public (and will be replaced in the paper files). A substitute redacted Order will be issued. Applicants are required to maintain a copy of the Order as originally issued in each application/patent.

**ON REQUEST
TO VACATE ORDER TO SHOW CAUSE
WHY DECISION REVIVING THIS APPLICATION
SHOULD NOT BE VACATED**

On November 11, 2008, applicants filed the REQUEST TO VACATE ORDER TO SHOW CAUSE WHY DECISION REVIVING THIS APPLICATION SHOULD NOT BE VACATED.

BACKGROUND

The above-identified application was filed on January 13, 1994. The application became abandoned on three occasions for failure to prosecute. The application is now expressly abandoned.

⁴ Pending a decision on this petition, the Orders were closed in the Image File Wrapper of the electronically-maintained applications and the paper files containing Orders were retained in the custody of the reviewing attorney.

This application first became abandoned for failure to respond to a Notice to File Missing Parts of Application mailed February 17, 1994. By decision mailed March 6, 1995, a petition to revive filed December 22, 1994 was granted.

This application again became abandoned on February 1, 1996 for failure to reply to the Office letter mailed on October 31, 1995. A Notice of Abandonment was mailed on June 12, 1996. More than 3 months after the mailing of the Notice of Abandonment, on October 1, 1996, applicants filed a petition to revive. By decision mailed November 26, 1996, the petition was granted.

The application became abandoned a third time on July 10, 1997 for failure to reply to the Office letter mailed on April 9, 1997. A Notice of Abandonment was mailed on November 12, 1997. More than 3 months later on February 3, 1998, a petition to revive was filed. On petition, attorney for applicants states that he has no record of receiving the Notice of Abandonment. By decision mailed April 15, 1998, the petition was granted for purposes of continuity with a continuing application. This application again became abandoned in favor of the continuing application.

On July 2, 2008, the Office issued an Order to Show Cause why the multiple decisions reviving the application should not be vacated. Considering a pattern of abandonment and revival in multiple applications, the Order required *inter alia* further information as to i) the cause of any delay between the date the application became abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, ii) the cause of any delay between the date the applicant was first notified that the application was abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, and iii) how these delays were "unintentional." The Order specifically required explanation of the docketing system used for recording due dates for response to an Office communication and how it operated, and copies of relevant docket entries. The Order set a two-month period for response with extensions of time obtainable under 37 CFR 1.136(a).

Applicants do not question the Office's jurisdiction to issue this Order in this abandoned application. Rather, applicants assert that i) the USPTO is applying the wrong standard for petitions to revive filed in 1994 and 1996, ii) that the Order

issued over ten years after the USPTO's grant of Enzo's last petition is unreasonable, and iii) the Order expresses an Opinion on the Validity, Patentability or Enforceability of a Patent.

**The Order to Show Cause sets forth
the proper standard under 37 CFR 1.137(b)**

First, applicants assert that the Office is applying the wrong standard on the basis that the USPTO erroneously asserts that Enzo was required to "show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition" was unintentional. Applicants argue that Enzo was only required under 37 C.F.R. § 1.137(b) to make a statement that "the entire delay ... was unintentional," which it did.

Applicants' assertion that the Office erred in referring to a required showing under 37 CFR 1.137(b) is unavailing. The Office stated that "during all periods relevant to the decisions on petition in the above-identified applications, Enzo was required to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional," and this statement is correct. Applicants make an inconsequential distinction between the "showing" required of 37 CFR 1.137(a) and the statement required of 37 CFR 1.137(b). The words "showing" and "statement" are used interchangeably by the Office.⁵ In the context of 37 CFR 1.137(b), the statement may suffice as the showing. Regardless, a focus on the use of the word "show" in one sentence ignores the several pages of the Order which set forth what the rule requires and addresses why the Office has deemed applicants' statement of unintentional delay to now be in question.

Moreover, the distinction drawn by applicants erroneously suggests that it is sufficient for applicant to state that the "delay was unintentional" and that this statement requirement

⁵ For example, with respect to the requirements of 37 CFR 1.47(b), MPEP 409.03(g) states that "Irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." Therein, showing and statement are used interchangeably. Moreover, a review of MPEP 711.03(c) would reveal that the Office uses the word "showing" in connection with unintentional delay and unavoidable delay.

does not reflect a burden on applicant to verify that the entire delay was unintentional when so questioned. This conclusion ignores the fact that the Office only has authority to revive an abandoned application where the delay was "unintentional" or "unavoidable." In both instances, the burden of proof is on applicants. This burden is lessened, but not eliminated, under 37 CFR 1.137(b) inasmuch as the statement generally suffices to satisfy the requirement of unintentional delay. In order to expedite treatment, applicants filing a petition under 37 CFR 1.137(b) to revive an abandoned application are allowed to state that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional," rather than to provide a detailed statement of facts showing that the entire delay was unintentional. The statement is found sufficient for this purpose because applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. As the burden of proof is on applicants, the Office remains able to ask additional questions if the statement alone is not deemed sufficient.

More importantly, semantics aside, the point made in the Order is that applicants in order to meet the requirements of 37 CFR 1.137(b) had to have properly made the required statement of unintentional delay. Implicit in this statement is that the actual circumstances of the abandonment of the application if presented in detail to the Office would support a conclusion that the entire delay from the due date for the reply until the filing of a grantable petition was unintentional. This statement is not properly made if it is not supported by the actual circumstances of the application. The Office will not question the statement unless something in the record raises a question as to the accuracy of the statement. In this particular instance, the Office did not have cause in each individual case to question the sufficiency or accuracy of the statement. Presently, given the pattern of abandonments and revivals, the Office does have cause to question the statement of unintentional delay.

Secondly, applicants assert that the Office is applying the wrong standard on the basis that the MPEP in effect in December 1994 and October 1996 made clear that a petition under 37 CFR 1.137(b) would generally be granted and the Office has provided

no evidence that the delay herein was intentional. Applicants maintain that the Order is not supported.

It is true that the Office generally grants petitions under 37 CFR 1.137(b), especially when the petition as in the instances in this case are filed within a year of the abandonment of the application. However, this does not mean that the Office must always grant petitions with the required statement. Rather, it is well-established that:

While the Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, the Office may require an applicant to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) where there is a question whether the entire delay was unintentional. See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989).

Further, even in 1994 and 1996, the rule, providing for revival based on unintentional delay, stated that the Director may require additional information where there is a question whether the delay was unintentional. As such, a grant under the unintentional standard was not and currently remains not a sure thing.

Moreover, applicants wrongly suggest that the Office must provide evidence that the delay was intentional. Rather, the Office should articulate a basis for their conclusion that there is a question whether the entire delay was unintentional. The burden is not on the Office to provide evidence that the delay was intentional. Applicants carry the burden of proof to establish that the "entire" delay was "unintentional." See In re Application of G, *supra*.

Finally, the Order to Show Cause is supported. The Order is based on the patterns of abandonment and revival detailed in the tables and text of the Order. Applicants argue that the purported pattern referenced in the Order relates to abandonments and revivals in other applications and this information has nothing whatsoever to do with this application or whether its delay was intentional. This argument is without

merit. The other applications are not random applications, but applications owned by and prosecuted on behalf of Enzo. The decisions to reply or not to reply, to file petitions to revive or not to file petitions to revive, were made by Enzo in these applications. The abandonment of an application is not a routine matter. Furthermore, the fact alone that Enzo on a regular basis had applications become abandoned and then revived is significant. Moreover, as stated in the Order, when looking at this pattern and seeing that many applications were revived just days short of the one year deadline, questions were raised. The pattern raises a question as to whether the delay in filing a reply or the delay in filing petitions was unintentional, as stated by applicants. The pattern raises questions as to the validity of all statements of unintentional delay ever made by or on behalf of Enzo. The Office has determined that the conclusion that applicants previously met their burden with their statements of unintentional delay may be incorrect. Accordingly the Office issued the Orders to Show Cause Why the Decision Reviving This Application Should Not be Vacated.

It is noted that applicants in response to this Order have not provided the additional information requested to answer the Office's questions. Applicants have reiterated the limited statements made on petition to revive. Applicants have not provided new statements or docketing records as requested.

**The Issuance of the Order to Show Cause
is not unreasonable**

Finally, applicants argue that the Order issued well over ten years after the Office's grant of Enzo's last petition is unreasonable. This period of time is not unreasonable. With respect to this application, this matter is current. Several continuation applications are currently pending before the Office. The Office has the authority to require information reasonably necessary to treatment of a matter in an application.

It is unfortunate that the Office did not recognize this pattern sooner. However, this delay by the Office has to be considered in light of applicants' action. The question being should the revival of applicants' application be sustained where applicants engaged in a pattern of what appears to be intentionally abandoning or intentionally delaying the filing of petitions to revive.

**By Issuing the Order Office Personnel Have Not
Expressed an Opinion on Validity, Patentability or
Enforceability of the referenced Patent**

Petitioner's argument that the Order impliedly and improperly casts aspersions on the validity or enforceability of a patent is not persuasive. The Order does not include any statement about the validity or invalidity of, or the patentability or unpatentability of any claim in the referenced patent, inconsistent with the public policy guidance set forth in MPEP 1701. In furtherance of this argument, page 11 of the Order is cited by petitioner. However, page 11 references this application but does not reference the application number or patent number of the patent petitioner alleges the Order casts aspersions on. Petitioner has extended the reach of the policy cited beyond its scope to reach the inferences or implications of statements made in applications to their possible interpretation in a patent.

CONCLUSION

The Order was properly issued. The response received does not include the additional information, including docketing records, requested by the Order.

Applicants are given a two (2) month extendable period under 37 CFR 1.136(a) to complete their response to the Order to Show Cause. Applicants should note that a future reply that is incomplete will be treated as non-responsive and additional time will not be given to complete the reply.

Telephone inquiries regarding this decision may be directed to Senior Petitions Attorney Nancy Johnson at 571-272-3219.



Charles Pearson
Director
Office of Petitions